

CHISUM ON PATENTS

A Treatise on the Law of Patentability, Validity and
Infringement

VOLUME 3

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INSTRUCTIONS: All material in this supplement is keyed to **SECTIONS** and **SUBSECTIONS** of the main volume. References to footnotes already in the volume are preceded by an "N." New footnotes do not have an "N."

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whether “whereby” and “thereby” clauses constitute a limitation on the scope of the claim.⁷² If the preamble is a limitation, it defines the scope of the claimed

⁷² See, e.g., *Lockheed Martin Corp. v. Space Systems/Loral, Inc.*, 249 F.3d 1314, 58 USPQ2d 1671 (Fed. Cir. 2001) (“a whereby clause that merely states the result of the limitations in the claim adds nothing to the substance of the claim. *Texas Instruments Inc. v. United States Int’l Trade Comm’n*, 988 F.2d 1165, 1172, 26 USPQ2d 1018, 1023-24 (Fed. Cir. 1993).”); *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 57 USPQ2d 1747 (Fed. Cir. 2001) (WHEREBY CLAUSE EXCLUDES PRIOR ART: a patent claim, properly interpreted to show infringement, would read on a prior art system; however, a “whereby” clause in the claim expressly excludes the prior art system); *Texas Instruments Inc. v. U.S. Int’l Trade Comm’n*, 988 F.2d 1165, 1171, 26 USPQ2d 1018, 1023 (Fed. Cir. 1993), discussed at § 18.03[1][a], § 18.04[5][a], § 18.05[2][c] (“A ‘whereby’ clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim.”); *Jackson v. Casio Phonemate, Inc.*, 105 F. Supp.2d 858, 867, 56 USPQ2d 1081, 1087-88 (N.D. Ill. 2000) (WHEREBY CLAUSE: “[a] ‘whereby’ clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim.” *Texas Instruments, Inc. v. United States Int’l Trade Comm’n*, 988 F.2d 1165, 1172 (Fed. Cir. 1993); see also *In re Certain Personal Computers and Components Thereof*, 224 U.S.P.Q. 270, 283, 1984 WL 64146 (U.S. Intern. Trade Comm’n, Mar. 9, 1984) (“Whereby clauses are given no weight if they express only a necessary result of the structure already recited in the body of the claims.”)); *Stimsonite Corp. v. Nightline Markers, Inc.*, 33 F. Supp. 2d 703, 709-710 (N.D. Ill. 1999), *aff’d*, 232 F.3d 908 (Fed. Cir. 2000) (unpublished) (“Although functional language is . . . permissible and ‘cannot be disregarded’ in a patent claim . . . , it does not always limit the claim in a substantive way.”; a “whereby” clause “simply state[d] the requisite consequence of forming a [structure] with the dimensions set forth in the . . . claims. It does not set forth an additional limitation. Nonetheless the functional language might still be helpful in interpreting the earlier element that it modified”); *Thermalloy Inc. v. Aavid Engineering Inc.*, 935 F. Supp. 55, 60, 39 USPQ2d 1457, 1461 (D. N.H. 1996), *aff’d*, 121 F.3d 691, 43 USPQ2d 1846 (Fed. Cir. 1997) (“The terms of the whereby clause must be regarded as an essential feature of the invention when a whereby clause is used to distinguish the invention over the prior art during prosecution of the patent.”); *Westvaco Corp. v. International Paper Co.*, 23 USPQ2d 1401, 1423 (E.D. Va. 1991), *aff’d*, 991 F.2d 735, 26 USPQ2d 1353 (Fed. Cir. 1993) (“A ‘whereby’ clause in a patent claim does not add any structural limitations to the claim and cannot constitute the inventive feature upon which the allowance of a patent is based.”); *Eltech Systems Corp. v. PPG Industries Inc.*, 710 F. Supp. 622, 633, 11 USPQ2d 1174, 1183 (W.D. La. 1988), *aff’d*, 903 F.2d 805, 14 USPQ2d 1965 (Fed. Cir. 1990) (“When the terms appearing in the whereby clause of a claim were emphasized as being effective for distinguishing over the prior art and in securing the allowance of that claim during the prosecution of the patent, those terms must be deemed an essential feature necessary to the establishment of infringement. If an accused product or process lacks this essential feature, it does not infringe.”); *In re Certain Personal Computers and Components Thereof*, 224 USPQ 270, 283 (U.S. Int’l Trade Comm. 1984) (“‘Whereby’ clauses are given no weight if they express only a necessary result of the structure already recited in the body of the claims.”).

Cf. *Hazani v. U.S. Int’l Trade Comm’n*, 126 F.3d 1473, 44 USPQ2d 1358 (Fed. Cir. 1997) (“thereby” clause).

In *Texas Instruments*, the patent concerned semiconductor device plastic encapsulation processes. Its claims contained two result-directed clauses: (1) “whereby the fluid will not directly engage the device and electrical connection means at high velocity, and the conductors will be secured against appreciable displacement by the fluid,” and (2) “to preclude direct high velocity engagement between the fluid and the device and the electrical connections thereto.” The court rejected the respondents’ argument that these clauses “establish specific further limitations” on fluid velocity

subject matter. It can be relied on to distinguish the claim from the prior art. It can be relied on to avoid infringement.

With Jepson-style improvement claims, it is clear that the preamble is a limitation.⁷³ With other types of preambles however, the answer is not so clear

and conductor securing structure. The clauses "merely describe the result of arranging the components of the claims in the manner recited in the claims: the fluid does not directly engage the device and the electrical connection means because the gate through which the fluid enters is remote from them; the conductors are secured against appreciable displacement by the fluid because they are clamped in notches by the upper and lower halves of the mold die." 988 F.2d at 1171-72, 26 USPQ2d at 1023-24.

⁷³ *Rowe v. Dror*, 112 F.3d 473, 479, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) ("the form of the claim itself, the so-called 'Jepson' form, suggests the structural importance of the recitations found in the preamble. The Jepson form allows a patentee to use the preamble to recite 'elements or steps of the claimed invention which are conventional or known.' 37 C.F.R. 1.75(e) (1996). When this form is employed, the claim preamble defines not only the context of the claimed invention, but also its scope."); *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 315, 227 USPQ 766, 770 (Fed. Cir. 1985) ("Although a preamble is impliedly admitted to be prior art when a Jepson claim is used, . . . unless the preamble is the inventor's own work, . . . the claimed invention consists of the preamble in combination with the improvement."); *Wells Mfg. Corp. v. Littelfuse, Inc.*, 547 F.2d 346, 192 USPQ 256 (7th Cir. 1976); *Xilinx, Inc. v. Altera Corp.*, 1998 WL 8229565 (N.D. Calif. 1998) (citing *Treatise*); *Light v. Hauss*, 200 USPQ 638 (Bd. of Pat. Int'l 1978); U.S. Patent and Trademark Office, *Manual of Patent Examining Procedure* § 608.01(m) (7th ed. 1998) ("The preamble of this form of claim is considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination.").

Compare *Depuy Orthopaedics, Inc. v. Androphy*, 53 USPQ2d 1941, 1956-57 (N.D. Ill. 2000) (distinguishing *Rowe*; a preamble in a claim in Jepson form recited "In a system for making triplanar bone resections for total knee replacement, the system including a set of instruments for resecting the anterior and posterior femoral condyles, the proximal tibia, and the distal femur, *the resections being made to provide equal flexion and extension gaps* . . . "; (emphasis added); HELD: the phrase, "provide equal flexion and extension gaps" is not a limitation; intrinsically set apart: "the limitations in the body of the claim are intrinsically set apart from the phrase 'equal flexion and extension gaps' in the preamble"; *ROWE v. DROR*: "Defendants rely on *Rowe v. Dror*, 112 F.3d 473 (Fed. Cir. 1997), to argue that the preamble of the Jepson form claim is considered to positively and clearly include all of the elements or steps recited therein as limitations on the claimed combination. . . . However, the Federal Circuit's reasoning in *Rowe* belies a blanket application of that rule to the instant case. In *Rowe*, the recited structure in the preamble was a balloon angioplasty catheter. . . . At issue was whether the term 'angioplasty' as an adjective acted as a limitation on the balloon catheter. . . . The court reasoned that 'the so-called "Jepson" form [itself], suggests the structural importance of the recitations found in the preamble.' . . . However in the instant case, the phrase 'equal flexion and extension gaps' does not suggest a particular type of general structure; rather, the phrase describes a result achieved by use of the apparatus defined in the claim."; "in the instant case, the phrase 'equal flexion and extension gaps' does not suggest a particular type of general structure; rather, the phrase describes a result achieved by use of the apparatus defined in the claim."; "The court finds the phrase of 'equal flexion and extension gaps' merely describes a purpose of the invention claimed in the . . . patent and does not act as structural limitation on the claimed invention.").

See § 8.06[1][c].

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and the decisions are difficult to reconcile. In general, it seems that a preamble will be considered a limitation if "the claim cannot be read independently of the preamble and the preamble must be read to give meaning to the claim or is essential to point out the invention."⁷⁴ On the other hand, a preamble will not be considered a limitation if "the preamble merely states a purpose or intended use and the remainder of the claim completely defines the invention."⁷⁵ It is well

But cf. *Western Broadcasting Co., Ltd. v. Capitol Records, Inc.*, 218 USPQ 94, 95 (N.D. Calif. 1981) ("Even if the claims here are in the form of Jepson claims, that does not necessarily make the old elements in the preamble part of a claimed combination. . . . The heart of the matter is still whether the references in the body of the claim are to the invention's intended environment or to parts of a combination. Ultimately, this can only be determined from the 'felt meaning' of the claim, as derived from the patent itself, the specifications, the drawings, and the file wrapper.").

⁷⁴ *Marston v. J.C. Penney Co.*, 353 F.2d 976, 986, 148 USPQ 25, 33 (4th Cir. 1965), *cert. denied*, 385 U.S. 974 (1966).

See also *Applied Materials Inc. v. Advanced Semiconductor Materials America, Inc.*, 98 F.3d 1563, 1573, 40 USPQ2d 1481, 1488 (Fed. Cir. 1996) ("Whether a preamble stating the purpose and context of the invention constitutes a limitation of the claimed process is determined on the facts of each case in light of the overall form of the claim, and the invention as described in the specification and illuminated in the prosecution history. See *In re Stencel* . . . (Fed. Cir. 1987) (the preamble is interpreted in light of the invention as a whole); *Perkin-Elmer Corp. v. Computervision Corp.* . . . (Fed. Cir. [1984]) . . . (the limitations stated in the preamble give meaning to the claim and can serve to define the invention). It is thus appropriate to determine whether the term in the preamble serves to define the invention that is claimed, or is simply a description of the prior art."); *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1819-20 (Fed. Cir. 1995) ("Much ink has . . . been consumed in debates regarding when and to what extent claim preambles limit the scope of the claims in which they appear. . . . These debates center . . . on particular arts and claiming styles and do not call into doubt the general principle, as well-settled as any in our patent law precedent, that a claim preamble has the import that the claim as a whole suggests for it. In other words, when the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects."); *Porter v. Farmers Supply Service, Inc.*, 790 F.2d 882, 885, 229 USPQ 814, 816 (Fed. Cir. 1986) (the preamble "gives meaning to other elements of the claimed invention"); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 7 USPQ2d 1315 (Fed. Cir. 1988); *Dow Chemical Co. v. Astro-Valcour, Inc.*, 47 F. Supp. 2d 294, 301-02 (N.D. N.Y. 1999) (citing *Treatise*); *Stranco Inc. v. Atlantes Chemical Systems Inc.*, 15 USPQ2d 1704, 1713 (S.D. Tex. 1990) ("The fact that a preamble is necessary to provide antecedent basis for subsequent language in the claim is significant in determining that the preamble is a claim limitation."); *Syntex (U.S.A.) Inc. v. Paragon Optical Inc.*, 7 USPQ2d 1001 (D. Ariz. 1987).

See also *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 221 USPQ 669 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 857 (1984).

⁷⁵ 353 F.2d at 986, 148 USPQ at 33.

See also *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1373-74, 58 USPQ2d 1508, 1511 (Fed. Cir. 2001) ("If the body of the claim sets out the complete invention, and the preamble is not necessary to give 'life, meaning and vitality' to the claim, 'then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation.' *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d